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| 10/828,541 | 04/20/2004 | Stuart A. Green | 286674.132US (HH/LHM/P104) | 3893 |
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| WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109 | | | DUNN, MISHAWN N | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.matthews@wilmerhale.com

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|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/828,541 | Applicant(s) GREEN, STUART A. | |
| | Examiner Mishawn N. Dunn | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-33 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-33 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lydecker et al. (US Pat. No. 5,903,701).

3. Consider claim 1. Lydecker et al. teaches a method for testing a digital content player, the method comprising: playing digital content using the digital content player, the digital content comprising identification data capable of being output by the digital content player to produce an identifiable output from the player; comparing an identifiable output corresponding to the digital content with the digital content or with a current location within the digital content to determine if the identifiable output of the player corresponds to an anticipated or expected position within the digital content; and assessing the player using that determination (col. 2, line 38 – col. 3, line 62).

4. Consider claim 2. Lydecker et al. teaches the method as claimed in claim 1, wherein comparing comprises sampling an output signal of the player and extracting the identifiable output from the sampled output signal (col. 2, line 38 – col. 3, line 62).

5. Consider claim 3. Lydecker et al. teaches the method as claimed in claim 1 wherein comparing comprises comparing the identifiable output with identification data associated with the digital content (col. 2, line 38 – col. 3, line 62).

6. Consider claim 4. . Lydecker et al. teaches a method for testing a number of media players, the method comprising: playing the same digital content using the media players, the digital content comprising identification data capable of causing the media players to produce respective identifiable outputs; comparing the identifiable outputs with anticipated or expected positions of the media players within the digital content; and assessing the media players in response to that comparison (col. 2, line 38 – col. 3, line 62).

7. Consider claim 5. Lydecker et al. teaches a method for testing a player, the method comprising: playing digital content using the player; and determining whether or not the current position of the player within the digital content corresponds to an expected or anticipated position of the player within the digital content (col. 2, line 38 – col. 3, line 62).

8. Consider claim 6. Lydecker et al. teaches a method of testing a player using a test standard in the form video image data, the method comprising: playing the video image data; and determining whether or not the output of the player is as anticipated or expected (col. 2, line 38 – col. 3, line 62; col. 6, lines 14-19).

9. Consider claim 7. Lydecker et al. teaches a method of testing a player using a test standard in the form video image data, the method comprising: playing the video image data using at least one player, and preferably a plurality of players; and determining whether or not the output of the player is as anticipated or expected by comparing the processing of that video image data by the at least one player, and

preferably the plurality of players, with the processing of that video image data using another player (col. 2, line 38 – col. 3, line 62; col. 6, lines 14-19).

10. Consider claim 8. Lydecker et al. teaches a method of testing a player for digital content, the method comprising: at least predicting, preferably processing or noting, the response of a first player to a first, respective, copy of digital content; processing the response of a second player to a second, respective, copy of the digital content; and judging whether or not the second player is acceptable (col. 2, line 38 – col. 3, line 62).

11. Consider claim 9. Lydecker et al. teaches a method of testing a player for digital content, the method comprising: at least predicting, preferably processing or noting, the response of a first player to a first, respective, copy of digital content and processing the response of a second player to a second, respective, copy of the digital content; and comparing at least the predicted response of the first player to the digital content with the noted response of the second player to the digital content and providing an indication of the result of the comparison (col. 2, line 38 – col. 3, line 62; col. 6, lines 9-13).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10-13, 15, 18-20, 25-33, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sashou et al. (US Pat. No. 4,858,027) in view of Official Notice.

14. Consider claim 10. Sashou et al. teaches a method of authoring digital content comprising: monitoring a response of a first player to processing the digital content and reauthoring digital content in response to the monitoring (col. 12, line 35 – col. 13, line 9).

Sashou et al. does not teach the digital content having verified as complying with an associated standard.

However, the examiner takes official notice that it is well known in the art to verify that digital content complies with an associated standard.

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to verify that digital content complies with an associated standard, in order to comply with a widely agreed upon set of guidelines for interoperability.

15. Consider claim 11. Sashou et al. teaches the method as claimed in claim 10, wherein monitoring comprises identifying unpredictable navigational behaviour of the player in response to a corresponding aspect of the digital content, and wherein reauthoring the content in response to the monitoring comprises at least of editing or deleting the corresponding aspect of the digital content to at least reduce, and preferably remove, the unpredictable navigational behaviour (col. 12, line 35 – col. 13, line 9).

16. Consider claim 12. Sashou et al. teaches all claimed limitations as stated above, except ensuring the reauthored digital content complies with an associated technical standard.

However, the examiner takes official notice that it is well known in the art to verify that digital content complies with an associated standard.

17. Consider claim 13. Sashou et al. teaches the method as claimed in claims 10, wherein monitoring comprises: playing the digital content using a reference player, playing the digital content using the first player; and comparing the navigational responses of the reference player and the first player to the digital content to identify a difference between the responses (col. 12, line 35 – col. 13, line 9).

Sashou does not teach that the reference player has been certified as being compliant with a respective technical standard.

However, the examiner takes official notice that it is well known in the art to have an apparatus that has been certified as being compliant with a respective technical standard.

18. Consider claim 19. Sashou teaches the method of testing as claimed in claim 18 further comprising analyzing data associated with selectable navigation paths of the digital content and selecting the control commands in response to analyzing (col. 12, line 35 - col. 13, line 9).

19. Consider claim 20. Sashou teaches the method as claimed in claim 19 wherein determining comprises comparing data associated with the responses of the plurality of players to the control commands with the analysis of the data associated with the

selectable navigation paths to determine a degree of correlation between the data associated with the responses and the data associated with the selectable navigation paths (col. 12, line 35 - col. 13, line 9).

20. Consider claim 25. Sashou et al. teaches the method as claimed in claims 18 further comprising creating, via a user interface, a plurality of control commands to be issued to the plurality of players (fig. 1).

21. Consider claim 26. Sashou et al. teaches the method as claimed in claim 25 further comprising storing the plurality of created control commands and wherein issuing control commands comprises retrieving the created control commands and issuing the retrieved control commands to the plurality of players (fig. 1).

22. Claims 15, 18, 27-33, and 36 are rejected using similar reasoning as the corresponding claim.

23. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sashou et al. (US Pat. No. 4,858,027) in view of Official Notice in view of Lydecker et al. (US Pat. No. 5,903,701).

24. Consider claim 14. Sashou et al. teaches all claimed limitations as stated above, except DVD video image data, including both presentation and navigation data.

However, Lydecker et al. teaches DVD video image data, including both presentation and navigation data (col. 6, lines 9-13).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to provide a DVD video image data, in order to digitally record video images.

25. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lydecker et al. (US Pat. No. 5,903,701) in view of Official Notice.

26. Consider claim 16. Lydecker et al. teaches using a DVD video image as a test standard for assessing performance of a DVD player (col. 6, lines 9-13).

Lydecker et al. does not teach the DVD being certified as complying with a technical specification.

However, the examiner takes official notice that it is well known to have a DVD being certified as complying with a technical specification.

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to verify that digital content complies with an associated standard, in order to comply with a widely agreed upon set of guidelines for interoperability.

27. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sashou et al. (US Pat. No. 4,858,027) in view of Official Notice in view of Blades et al. (US Pat. No. 5,420,975).

28. Consider claim 21. Sashou et al. teaches all claimed limitations as stated above, except identifying a plurality of menu choices; selecting one menu choice from the

plurality of menu choices; and selecting the control command according to the selected menu choice.

However, Blades et al. teaches identifying a plurality of menu choices; selecting one menu choice from the plurality of menu choices; and selecting the control command according to the selected menu choice (abstract).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to identify a plurality of menu choices, select one menu choice from the plurality of menu choices, and select the control command according to the selected menu choice, in order to automatically alter a menu display.

29. Consider claim 22. Blades et al. teaches the method as claimed in claim 21 wherein selecting one menu choice comprises: determining the respective number of times that the plurality of menu choices have been invoked; and selecting the one menu choice according to the respective number of invocations (abstract).

30. Consider claim 23. Sashou et al. teaches all claimed limitations as stated above, except identifying the data as being associated with a predeterminable function, the predeterminable function governing an onward navigation path selectable from a plurality of possible onward navigation paths; and wherein determining whether or not the plurality of players processed the data associated with the selectable navigation paths through the digital content comprises identifying the onward navigation path from the data processed by the plurality of players.

However, Blades et al. teaches identifying the data as being associated with a predeterminable function, the predeterminable function governing an onward navigation

path selectable from a plurality of possible onward navigation paths; and wherein determining whether or not the plurality of players processed the data associated with the selectable navigation paths through the digital content comprises identifying the onward navigation path from the data processed by the plurality of players (figs. 4A-E).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to identify data as being associated with a predeterminable function, the predeterminable function governing an onward navigation path selectable from a plurality of possible onward navigation paths, in order to not require a direct action by the user.

31. Consider claim 24. Blades et al. teaches the method as claimed in claim 23 wherein analyzing data associated with selectable navigation paths comprises generating data associated with each possible onward navigation path; and wherein identifying the onward navigation path comprises discarding the generated data associated with selectable possible onward navigation paths (figs. 4A-E).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Mishawn Dunn
January 5, 2008


THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
BIOLOGY CENTER 2600